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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,103	10/05/2000	Douglas U. Mennie	47171-00271	3137

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JENKENS & GILCHRIST, P.C.
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CHICAGO, IL 60606

EXAMINER

SHAPIRO, JEFFERY A

ART UNIT	PAPER NUMBER
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3653

DATE MAILED: 10/21/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,103

Applicant(s)

MENNIE ET AL.

Examiner

Jeffrey A. Shapiro

Art Unit

3653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-29, 78-89 and 146-149 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-29, 78-89 and 146-149 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/7/03 has been entered.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 7-29, 58-77, 78-89 and 146-149 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kobayashi et al (US 4,880,096) in view of Takizawa et al (US 5,201,395). Kobayashi et al discloses the following.

As described in Claims 7-29, 78-89 and 146-149;

1. an input receptacle (1);
2. at least one output receptacle (note that the apparatus disgorges bills at the end of conveyor (5b);
3. a transport mechanism (5a and 5b);

4. a magnetic scanhead (H1 and H2) disposed adjacent to the transport path, the scanhead including a plurality of closely spaced magnetic sensors, each of the magnetic sensors being adapted to detect magnetic zone printing configuration information from each of the currency bills, each of the magnetic sensors adapted to detect the presence of a security thread within each of the bills, the magnetic scanhead being adapted to determine a location of a detected security thread within a currency bill (see col. 7, lines 15-22 which indicates that magnetic pattern information is located on a bill in a pattern which can be identified by the system—note that at the very least, it would be inherent for a master pattern to be provided for comparison to the detected pattern of the currency, otherwise such a bill validator would not work);

Kobayashi et al does not expressly disclose, but Takizawa et al discloses the following.

5. a memory (16) adapted to store master magnetic zone printing configuration information (13)(see col. 3, lines 65-67 and col. 4, lines 1-3 of Takizawa) and master security thread location information (note that in order for the bill validator to work, it must have memory, and that such memory can be adapted to store any required information—see also figure 1);

6. an evaluation unit (19 and 20) adapted to determine the denomination of each of the bills by comparing detected magnetic zone printing configuration information to the stored master magnetic zone printing configuration information, the evaluation unit being adapted to authenticate each of the currency bills by comparing the determined security thread location to the stored master security thread location information (see col. 5, lines 27-60); (Note that col. 3, lines 42-51 describes classifying the bill based on which side of the bill and which of the two ends of the bill are facing frontwards. Note that it would appear to be expedient for one ordinarily skilled in the art to also include the two long edges of the bill in such an evaluation. Note also that the two ends could be construed to be the two long edges.)

Both Kobayashi et al and Takizawa et al are analogous art as they both concern discriminating paper currency.

At the time of the invention, it would have been obvious to use the bill examination circuitry (such as illustrated in figure 1 of Takizawa) in the bill validator of Kobayashi.

The suggestion/motivation would have been to increase the reliability of the genuineness test of a bill. See abstract and col. 1, lines 24-36 of Takizawa, noting that the system of Takizawa may be used with a magnetic detector.

Therefore, it would have been obvious to combine Kobayashi et al and Takizawa et al to obtain the invention as described in Claims 7-29, 78-89 and 146-149.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 7-29, 78-89 and 146-149 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the Claims of each of the following U. S. Patent No.'s individually. They are;

5,295,196; 5,430,664; 5,467,405; 5,790,697; 5,790,697; 5,806,650; 5,815,592;
5,867,589; 5, 870,487; 5,875,259; 5,905,810; 5,992,601; 6,012,565; 6,073,744;
6,220,419 B1; 6,237,739 B1; 6,241,069 B1; 6,278,795 B1; 6,311,819.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they either claim an apparatus that can perform the method, a method, or a combination of method and apparatus directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

6. Claims 7-29, 78-89 and 146-149 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 164-327 of both copending Application No.'s 09/541,170 and 09/542,487; Claims 157, 158 and 164-190 of copending Application No. 09/635,967; Claims 164-337 of copending Application No. 09/607,019; Claims 1-145 of copending Application No. 09/611,279; Claims of Application No. 09/126,580. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are directed toward the following.

a method and apparatus for discriminating and counting currency bills including receiving a stack of bills, transporting the bills, counting and determining the denominations of the bills utilizing a detector, determining whether the bills fail or meet certain criteria, halting the transporting when a failing bill is identified, and placing the failed bill as the last bill in one of the output receptacles.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The Examiner notes that Application 09/864,423, which is commonly owned by the Applicants is currently unavailable to the Examiner for review of double patenting issues.

Response to Arguments

7. Applicant's arguments with respect to Claims 7-29, 78-89 and 146-149 have been considered but are moot in view of the new ground(s) of rejection. See arguments above.

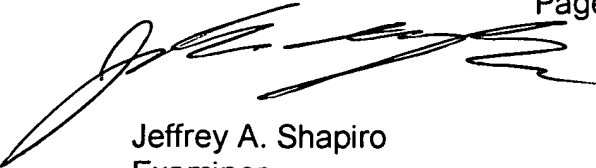
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

Application/Control Number: 09/684,103
Art Unit: 3653

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A handwritten signature in black ink, appearing to read 'Jeffrey A. Shapiro', written in a cursive style.

Jeffrey A. Shapiro
Examiner
Art Unit 3653

October 20, 2003

A handwritten signature in black ink, appearing to read 'Donald P. Walsh', written in a cursive style.

DONALD P. WALSH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600